

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF WISCONSIN

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PROMEGA CORPORATION,

Plaintiff,

MAX-PLANCK-GESELLSCHAFT ZUR  
FORDERUNG DER WISSENSCHAFTEN  
E.V.,

Involuntary Plaintiff,

Case No.: 10-CV-281

v.

LIFE TECHNOLOGIES CORPORATION,  
INVITROGEN IP HOLDINGS, INC., and  
APPLIED BIOSYSTEMS, LLC,

Defendants.

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**STIPULATION TO UNSEAL PORTIONS OF THE RECORD**

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Pursuant to Federal Circuit Rule 11(d), Plaintiff Promega Corporation (“Promega”) and Defendants Life Technologies Corporation, Invitrogen IP Holdings, Inc., and Applied Biosystems, LLC (collectively, “Defendants”) hereby stipulate to unseal portions of the record.

This case is currently on appeal before the United States Court of Appeals for the Federal Circuit. Federal Circuit Rule 11(d) requires that:

If any portion of the record in the trial court is subject to a protective order and a notice of appeal has been filed, each party must promptly review the record to determine whether protected portions need to remain protected on appeal. If a party determines that some portions no longer need to be protected, that party must seek an agreement with the other party. **Any agreement that is reached must be promptly presented to the trial court, which may issue an appropriate order.**

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Fed. Cir. R. 11(d) (emphasis added).<sup>1</sup> Upon review of the record, the parties have determined that the following documents need not remain protected on appeal:

| <b>Dkt. No.</b> | <b>Description</b>  |
|-----------------|---|
| 1-1             | Exhibit A - U.S. Patent No. 5,843,660   |
| 1-2             | Exhibit B - U.S. Patent No. 6,221,598   |
| 1-3             | Exhibit C - U.S. Patent No. 6,479,235   |
| 1-4             | Exhibit D - U.S. Patent No. 7,008,771   |
| 1-5             | Exhibit E - U.S. Patent No. RE37,984  |
| 5-1             | Exhibit A - U.S. Patent No. 5,843,660   |
| 5-2             | Exhibit B - U.S. Patent No. 6,221,598   |
| 5-3             | Exhibit C - U.S. Patent No. 6,479,235   |
| 5-4             | Exhibit D - U.S. Patent No. 7,008,771   |
| 5-5             | Exhibit E - U.S. Patent No. RE37,984  |
| 10              | Motion for Leave to Maintain Documents Under Seal   |
| 61              | Motion to Deny Arbitration, or, in the Alternative, Stay Arbitration Pending Determination of Arbitrability             |
| 68              | Defendants' Answer to Promega Corp's First Amended Complaint and Counterclaims Against Promega Corp. [FILED UNDER SEAL] |
| 228             | Promega Corp's Brief In Support of Summary Judgment [FILED UNDER  |

<sup>1</sup> Because confidentiality of the record is a collateral matter not affecting any issues presented on appeal, this Court retains jurisdiction to enter such an order. *See United Teacher Assocs. Ins. v. Union Labor Life Ins.*, 414 F.3d 558, 572 (5th Cir. Tex. 2005) ("the filing of an appeal divests the district court of its control only over those aspects of the case involved in the appeal") (quoting *Griggs v. Provident Consumer Discount*, 459 U.S. 56, 58 (1982) (internal quotations omitted); *Weaver v. Fla. Power & Light Co.*, 172 F.3d 771 (11th Cir. 1999) ("The general rule regarding divestiture of jurisdiction" does "not apply to collateral matters not affecting the questions presented on appeal.")).

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|                 | SEAL]  |
| 236             | Declaration of R. Dimond In Support of Promega's Motion for Summary Judgment [FILED UNDER SEAL]  |
| 245             | Defs Brief In Support Of Motion For Partial Summary Judgment [FILED UNDER SEAL]  |
| 245-1           | Appendix A to Defs Brief In Support Of Motion For Partial Summary Judgment – '544 Patent History Summaries [FILED UNDER SEAL]  |
| 245-2           | Appendix B to Defs Brief In Support Of Motion For Partial Summary Judgment – Claim Chart [FILED UNDER SEAL]  |
| 245-3           | Appendix C to Defs Brief In Support Of Motion For Partial Summary Judgment – Statements Made by Promega During Prosecution of the Promega Patents Regarding the Unpredictable State of the Art and the Undue Experimentation Required to Multiplex Each New Set of Loci [FILED UNDER SEAL] |
| 246             | Promega's Proposed Findings of Fact In Support Of Motion for Summary Judgment re U.S. Patent Nos. 6,211,598; 5,843,660; 6,479,235; 7,008,771; and RE 37984 [FILED UNDER SEAL]  |
| 257             | Defs Responses to Promega's Proposed Findings of Fact In Support of Promega's Motion for Summary Judgment [FILED UNDER SEAL]   |
| 280             | Promega's Reply Brief In Support of Summary Judgment [FILED UNDER SEAL]  |
| 326             | Declaration of Randall Dimond in Support of Promega Corp's Third Motion to Compel  |
| 342-1 to 342-30 | Exhibits Including Product Inserts, User Manuals, Website Printouts (report itself should remain sealed)   |
| 388-11          | Exhibit K to Declaration of S. E. Troupis In Support of Promega's Motion In Limine – Declaration of Guido Sandulli [FILED UNDER SEAL]  |
| 463             | Motion for Leave to File Updated Supplemental Report (report itself should remain sealed)  |
| 511             | Promega's Brief In Support Of Motion to Find Defs Assertions Re Forensic Education, Forensic Training and Forensic Research as Untimely and Waived [FILED UNDER SEAL]  |

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|-----|--------------------------------|
| 674 | Declaration of Jack Ballantyne |
| 675 | Declaration of Margaret Ewing  |
| 676 | Declaration of Kathleen Murphy |

IT IS SO STIPULATED.

This Stipulation made and entered into this 11<sup>th</sup> day of July, 2013.

By: /s/ Thomas G. Saunders

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